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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/806,894	03/23/2004	Larry S. Eoff	2001-IP-005267U1P2	2392	
71407	7590	12/17/2008			
ROBERT A. KENT		EXAMINER			
P.O. BOX 1431		FIGUEROA, JOHN J			
DUNCAN, OK 73536			ART UNIT	PAPER NUMBER	
			1796		
		NOTIFICATION DATE	DELIVERY MODE		
		12/17/2008	ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/806,894	<b>Applicant(s)</b> EOFF ET AL.
	<b>Examiner</b> John J. Figueroa	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 September 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-38 is/are pending in the application.  
 4a) Of the above claim(s) 7 and 11-38 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6 and 8-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1468)  
 Paper No(s)/Mail Date 9/9/08; 10/27/08; & 11/17/08.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The 35 U.S.C. §112, second paragraph, rejection of claims 1-6 and 8-10 previously made of record in item 4 on page 3 of the Office Action dated June 13, 2008 (hereinafter 'OA') has been withdrawn in view of Applicant's amendment to sole independent claim 1 in the response to OA filed September 11, 2008 (hereinafter 'Response').
2. The 35 U.S.C. §102(b) rejection of claims 1-6 and 8-10 as anticipated by U.S. Patent Application Publication No. 2003/0013871 A1 to Mallon et al. (hereinafter 'Mallon') has been maintained for the same reasons previously made of record in item 6 on page 3 of OA.

### ***Response to Arguments***

#### **The 35 U.S.C. §102 Rejection over Mallon (item 6 of FOA)**

3. Applicant's arguments in Response with respect to the 35 U.S.C. 102(b) rejection of claims 1-6 and 8-10 as anticipated by Mallon have been fully considered but deemed unpersuasive.

Applicant's primary argument in Response traversing the captioned rejection is that Mallon does not disclose the alkyl side chain of its polymer having the same

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number of carbons as the polymer of the present invention. Particularly, Applicant states:

"... [W]ith respect to independent claim 1, Mallon fails to disclose "a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer." Although *Mallon may disclose reacting chitosan with a salt having up to three carbons*, Mallon fails to disclose a "hydrophobically modified" polymer as defined by Applicants ... [because] ... *Applicants have defined "hydrophobically modified" to refer to the incorporation into the hydrophilic polymer structure of hydrophobic groups, wherein the alkyl chain length is from about 4 to about 22 carbons.* (See Specification, ¶ [0018]) ... As the ... *hydrophobic compounds of Mallon comprise up to three carbons*, their incorporation into a hydrophilic polymer would not constitute hydrophobic modification. See Mallon, ¶ [0018] ... Therefore, Applicants respectfully submit that Mallon fails to disclose a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer. As such, the cited reference does not anticipate this claim." [Emphasis added by Examiner.]

That is, Applicant alleges that the polymer disclosed in Mallon does not anticipate the polymer component of the relative permeability modifier recited in independent claim 1 because its alkyl chain has 3 carbons whereas that of the present invention has "about 4 to about 22 carbons" (as defined in the cited paragraph of the present specification and recited in instant claim 8). This argument has been determined as unpersuasive because the first endpoint of the recited range disclosed in the specification cited by Applicant ("about 4 carbons") must encompass an alkyl chain having three carbons. Because a range of carbons numbers for an alkyl chain must all be integers (a side chain can not contain an alkyl chain having a length of, for example, 3 and a half carbons), the term "about" implies that three carbons may anticipate this range limitation of the claim. Otherwise, the term "about" in the present claims would be superfluous.

Moreover, *assuming arguendo*, in accordance with the doctrine of claim differentiation, dependent claim 8 would not be further limiting because it recites the

same exact range of carbon numbers for the alkyl side chain that Applicant now alleges is implicit in independent claim 1.

Furthermore, as to claims 1-6, 9 and 10 specifically, it is noted that this range limitation for the alkyl chain that Applicant relies upon is not recited in these rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, the instant claims, as amended, remain anticipated by Mallon.

#### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RPG

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796